UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,358	02/23/2004	Andrew J. Vilcauskas JR.	KLR/KAR:8096.0011	8814

152 7590 01/24/2008

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204-3157

EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
01/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,358	VILCAUSKAS ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/4/07, 9/4/07, and 11/19/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 10/15/2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 7, these claims recite the limitation "where said first and second platforms are both free from instructions capable of automatically, without user interaction, causing said second platform in said background of said media to replace said first platform in said foreground of said media". While Applicant's specification appears to show a user initiating a view-triggering event, Applicant's specification does not appear to specify that the platform windows do not have any automatic instructions that could perform the replacing step automatically. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 2, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1 and 7, these claims recite the limitation "where said first and second platforms are both free from instructions capable of automatically, without user interaction, causing said second platform in said background of said media to replace said first platform in said foreground of said media". Later in the claims, the following limitation is recited "said first platform is at least partially obscured by said second platform, during a time interval beginning incrementally prior to...". If the platforms have no automatic viewing instructions, then the viewing of these windows is left at the user's discretion (whenever the user chooses to initiate a view triggering event). It is unclear how a time interval for viewing (which signifies an automatic process) can be implemented when no automatic viewing instructions are available (the user could essentially initiate a view triggering event whenever he/she wants, regardless of timing).

Regarding claim 2, this claim recites the limitation "said step of opening a post-session platform". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-3 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werkhoven (WO 99/59097).**

Regarding claims 1, 2, and 7-12, Werkhoven teaches the displaying of a first display on a web browser in the foreground of a computer(when user opens a Web Page) (Page 4, Lines 1-6, and Figure 1), the initiating of a load triggering event (opening the web page) (Page 4, Lines 1-6, and Figure 1), the opening of a post-session web browser in the background of the computer (the background window is a post-session platform) (Page 4, Lines 1-6, and Figure 1), the displaying of a post-session display on the background window (the advertisement) (Page 4, Lines 1-6, and Figure 1), and the maintaining of the background window in the background until the advertisement is fully loaded, thus bringing it to the foreground. Werkhoven does not appear to specify a viewer-driven view triggering event that brings the advertisement window forward without automatic programming. Official notice is taken that "minimize window", "close window", and "alt-tab" are all old and well-known functions programmed into typical user operating systems. Windows 95 is an example of a widely used operating system at that time and predates applicants invention by several years. Windows 95 allowed users to close and minimize windows by any number of methods, arguably the easiest being the "X" and "_" buttons located at the upper right of every window. Windows 95 also allowed for switching between windows by holding the "alt" key, and subsequently depressing "tab". It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the functionality to give users the ability to close or switch between (both being viewer driven view triggering events) windows at their own discretion (the functionality of which is taught by Windows 95)

regardless of whether the advertisement was finished loading or not, thus giving the user the freedom to browse information on the computer in whichever order as the user sees fit.

Regarding claim 3, Werkhoven teaches that there is a predetermined time interval before the post-session window disappears (Claim 3).

Regarding claims 5 and 13, Werkhoven teaches that a certain time period lapses before the window goes away. This is taken to read on the focus timer process. (Page 4, Lines 5-6).

Regarding claim 6, Werkhoven teaches the waiting of a predetermined time interval before being able to open the post-session platform (Claim 4).

Response to Arguments

4. Applicant argues "Not only does Werkhoven fail to disclose this limitation, but teaches away from it, as the method of Werkhoven depends on code that automatically pushes the first displayed advertisement to the foreground once it has fully loaded". While Werkhoven does indeed teach the pushing of advertisements to the foreground automatically, nowhere in Werkhoven does it say that the pushing of advertisements to the foreground can't be done manually. Just because a prior art teaches one method does not mean that prior art automatically teaches away from an alternative.

5. Further, Applicant's invention appears to be a step back in the art with regards to this manual process. Wekhoven has simply automated a process that was already manual (switching of windows in the foreground). Examiner has provided evidence that this manual process is well known (in the form of Windows 95). It would be obvious to implement these manual features as taught by Windows 95 in the invention of Werkhoven. This is regardless of whether the advertisement is fully loaded or not. The process of loading the

advertisement in the background and bringing it forward is taught by Werkhoven. The process of moving windows back and forth manually is taught by Windows 95. It would be obvious to perform this manual operation at the user's discretion, whether the advertisement is fully loaded or not.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622